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PATENT


Serial No. 09/456,689

Appeal Brief in Reply to Notice of Panel Decision from
Pre-Appeal Brief Review of April 26, 2006

TO THE UNITED STATES PATENT AND TRADEMARK OFFICE

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By 
(Signature) Dicran Halajian

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

MICHAEL S. PASIEKA

PHA 23871

Serial No. 09/456,689

Confirmation No. 6774

Group Art Unit: 2136

Filed: DECEMBER 9, 1999

Examiner: PARTHASARATHY, P.

Title: METHOD AND APPARATUS FOR REVOCATION LIST MANAGEMENT

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Board of Patent Appeals and Interferences
United States Patent and Trademark Office
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Sir:

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PHA23871-appeal cover-05-26-06.DOC


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In addition, please credit any overpayments related to any fees paid in connection with the present Appeal Brief to Deposit Account No. 50-3649.

Respectfully submitted,

By 
Dicran Halajian, Reg. 39,703
Attorney for Appellant
May 26, 2006

Enclosure: Appeal Brief (24 pages)
Authorization to charge credit card \$500 for Appeal
Brief fee

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APPEAL BRIEF

Sir:

Appellant herewith respectfully presents a Brief on Appeal as follows, in response to the Notice of Panel Decision from Pre-Appeal Brief Review of April 26, 2006, having filed a Notice of Appeal and a Pre-Appeal Brief Request for Review on February 9, 2006:

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REAL PARTY IN INTEREST

The real party in interest in this appeal is the assignee of record Koninklijke Philips Electronics N.V., a corporation of The Netherlands having an office and a place of business at Groenewoudseweg 1, Eindhoven, Netherlands 5621 BA.

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RELATED APPEALS AND INTERFERENCES

Appellant and the undersigned attorney are not aware of any other appeals or interferences which will directly affect or be directly affected by or having a bearing on the Board's decision in the pending appeal.

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STATUS OF CLAIMS

Claims 1-20 are pending in this application. Claims 1-10 and 12-20 are rejected in the Final Office Action mailed December 19, 2005, and claim 11 is indicated as being allowable if rewritten in independent form. Claims 1-10 and 12-20 are the subject of this appeal.

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STATUS OF AMENDMENTS

Appellant filed a Pre-Appeal Brief Request for Review on February 9, 2006, in response to a Final Office Action dated December 19, 2005. No amendments to the claims were made in response to the Final Office. This Appeal Brief is in response to the Final Office Action mailed December 19, 2005 that finally rejected claims 1-10 and 12-20, which are indicated to proceed to the Board of Patent Appeals and Interferences in the Notice of Panel Decision from Pre-Appeal Brief Review mailed on April 26, 2006.

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SUMMARY OF THE CLAIMED SUBJECT MATTER

The present invention, for example, as claimed in independent Claims 1 and 16-17, include a method and system for controlling access to information, where illustrative embodiments are shown in FIGs 1-5.

As shown in an illustrative embodiment in FIG 1 and described on page 7, line 17 to page 8, line 5 of the specification, for example, an apparatus 100 for controlling access to information 165 includes a processor-based device 110 for controlling access to the information 165.

A revocation list 150, which may be stored locally for example, includes revoked identifiers 122 of entities where, for example, the revoked identifiers 122 may be broadcast to access control apparatus 100, as described on page 9, line 22, to page 10, line 2.

The processor-based device 110 is operative to maintain a contact list 300 where one embodiment is shown in FIG 3 and described on page 13, line 14, to page 14, line 22. For example,

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as shown in FIG 3, the contact list 300 includes information identifying one or more other entities which have attempted to communicate with the processor-based device.

In addition, the processor-based device 110 is operative to utilize the contact list 300 in conjunction with the revocation list 150 associated with the given entity to determine which of at least a subset of the one or more other entities are authorized to communicate with the processor-based device 110. For example, as described on page 8, lines 1-5, entities are allowed to communicate with the given entity if an access identifier 114, shown in FIG 1, is an authorized identifier, such as when the entity is not included in the revocation list 150, which is updated in response to receipt of the revoked identifiers 122.

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GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1-10 and 12-20 of U.S. Patent Application
Serial No. 09/456,689 are anticipated under 35 U.S.C. §102(e) by
U.S. Patent No. 6,389,538 (Gruse).

Appellant respectfully requests the Board to address the
patentability of independent claims 1 and 16-17, and of further
claims 2-10, 12-15 and 18-20 as depending from claims 1 and 16-17,
based on the requirements of independent claims 1 and 16-17. This
position is provided for the specific and stated purpose of
simplifying the current issue on appeal. However, Appellant
specifically reserves the right to argue and address the
patentability of 2-10, 12-15 and 18-20 at a later date should the
separately patentable subject matter of 2-10, 12-15 and 18-20 later
become an issue. Accordingly, this limitation of the subject
matter presented for appeal herein, specifically limited to
discussions of the patentability of independent claims 1 and 16-17
is not intended as a waiver of Appellant's right to argue the
patentability of the further claims and claim elements at that
later time.

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ARGUMENT

I. Claims 1-10 and 12-20 are said to be anticipated by Gruse.

At the outset, it is respectfully submitted that Gruse has 21 sheets of drawings and 98 columns of text qualifying this patent as "complex". Therefore pursuant to 37 CFR 1.104, the Examiner must indicate how the reference is being applied. As discussed below, it is respectfully submitted that the indicated sections of Gruse do not teach or suggest the present invention as recited in independent claims 1 and 16-17.

Gruse is directed to a system for tracking end-user electronic content usage. What Gruse describes (in column 45, lines 17-56) is a "Clearinghouse", which maintains a list of revoked digital certificates, not a "contact list comprising information identifying other entities which have attempted to communicate with" the Clearinghouse - in as much as the Clearinghouse of Gruse may be construed as the "given entity" of Claim 1, as the Examiner seems to do.

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The system described by Gruse actually corresponds to the conventional technique described in the "Background of the Invention" section of the present application (page 2, line 12 to page 3, line 11). In this kind of system, an issuing authority (clearinghouse) maintains and periodically publishes an updated list of revoked identifiers. This updated list is communicated to each access control system (end user), which in turn uses the updated list to update its own, local revocation list.

In the system described by Gruse there is no "contact list" used in conjunction with the "revocation list" as set forth in Claim 1. In the Final Office Action dated December 19, 2005, (page 4, lines 3-10) the Examiner cites two lists that are used by the Clearinghouse, and misconstrues one of them as the "contact list". A careful reading of Gruse shows that the two lists maintained by the Clearinghouse are: 1. a list of all the digital certificates that have been assigned; and 2. a list of the subset of digital certificates that have been revoked.

Further, on page 4, first full paragraph of the Final Office Action, column 45, line 44 to column 46, line 25 is cited to

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allegedly show that the Gruse:

Clearinghouse(s) 105 utilizes both the contact list and the revocation list to determine to verify the integrity and the validity of the digital signature and authorizes secure digital content electronic distribution system.

It is respectfully submitted that a careful reading of column 45, line 44 to column 46, line 25 reveals no teaching or suggestion of a contact list, let alone teaching or suggesting "utilizing a contact list in conjunction with a revocation list associated with the given entity to determine which of at least a subset of the one or more other entities are authorized to communicate with the given entity," as recited in independent claim 1, and similarly recited in independent claims 16-17.

Further, regarding claims 16 and 17, the Examiner stated in the Final Office Action dated December 19, 2005, that the limitations "a processor-based device" (claim 16) and "a machine-readable storage medium containing one or more software programs for use in controlling access to information" (claim 17) have "not been given patentable weight because the recitation occurs in the preamble." Appellant respectfully but strongly traverses this

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assertion, and submits that these limitations should be given full patentable weight. The MPEP, §2111.02 sets forth the effect of the preamble on patentability as follows:

The determination of whether a preamble limits a claim is made on a case-by-case basis in light of the facts in each case; there is no litmus test defining when a preamble limits the scope of a claim. *Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808, 62 USPQ2d 1781, 1785 Fed. Cir. 2002).

The Examiner did not provide any arguments supporting the decision to deny any patentable weight to the preambles of claims 16 and 17.

Furthermore, Appellant submits that the Examiner did in fact mistakenly place the above-recited limitations in the preambles of claims 16 and 17 when they are actually not part of said preambles. These limitations are recited after the transitional phrase "comprising" and should therefore be given full weight in defining the scope of the claims, as set forth in the MPEP, §2111.03:

The transitional phrases "comprising", "consisting essentially of" and "consisting of" define the scope of a claim with respect to what unrecited additional components or steps, if any, are excluded from the scope of the claim.

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See also:

Genentech, Inc. v. Chiron Corp., 112 F.3d 495,
501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997)
("Comprising" is a term of art used in claim
language which means that the named elements are
essential, but other elements may be added and
still form a construct within the scope of the
claim.)

Accordingly, Appellant submits that the limitations "a
processor-based device" (claim 16) and "a machine-readable storage
medium containing one or more software programs for use in
controlling access to information" (claim 17) should be given their
full and due patentable weight, and that the cited art reference
does not teach or suggest these limitations in conjunction with the
other patentable features as set forth in claims 16 and 17.

In summary, it is respectfully submitted that Gruse simply
does not teach or suggest the present invention as recited in
independent claim 1, and similarly recited in independent claims
16-17 which, amongst other patentable elements, requires:

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maintaining, for a given entity controlling access to the information, a contact list comprising information identifying one or more other entities which have attempted to communicate with the given entity; and utilizing the contact list in conjunction with a revocation list associated with the given entity to determine which of at least a subset of the one or more other entities are authorized to communicate with the given entity. (Illustrative emphasis added)

Accordingly, it is respectfully submitted that independent claims 1, 13-14 and 17 are allowable, and allowance thereof is respectfully requested. In addition, it is respectfully submitted that claims 2-12 and 15-16 should also be allowed at least based on their dependence from independent claims 1 and 14.

In addition, Appellant denies any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. Any rejections and/or points of argument not addressed would appear to be moot in view of the presented remarks. However, the Appellant reserves the right to submit further arguments in support of the above stated position, should that become necessary. No arguments are waived and none of the Examiner's statements are conceded.

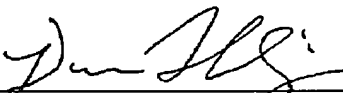
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CONCLUSION

Claims 1-10 and 12-20 are patentable over Gruse. Thus, the rejection of claims 1-10 and 12-20 should be reversed.

In view of the above, it is respectfully submitted that the present application is in condition for allowance, and a Notice of Allowance is earnestly solicited.

Respectfully submitted,

By 
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May 26, 2006

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CLAIMS APPENDIX

1.(Original) A method for controlling access to information,
the method comprising the steps of:

maintaining, for a given entity controlling access to the
information, a contact list comprising information identifying one
or more other entities which have attempted to communicate with the
given entity; and

utilizing the contact list in conjunction with a revocation
list associated with the given entity to determine which of at
least a subset of the one or more other entities are authorized to
communicate with the given entity.

2.(Original) The method of claim 1 wherein the given entity
and at least a subset of the one or more other entities each
comprise a consumer electronics device.

3.(Original) The method of claim 1 wherein the maintaining
and utilizing steps are implemented in an access control system
associated with the given entity.

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4. (Original) The method of claim 3 wherein the revocation list comprises a local revocation list stored in the access control system.

5. (Original) The method of claim 1 wherein the contact list comprises a plurality of entries, each entry including at least an identifier of a particular one of the other entities and a corresponding revocation flag indicating whether authorization of the particular entity has been revoked.

6. (Original) The method of claim 5 further including the step of updating the contact list after a modification of the revocation list.

7. (Previously presented) The method of claim 6 wherein the step of updating the contact list after a modification of the revocation list further includes the steps of:

identifying all of the entities in the contact list that do

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not have their corresponding revocation flag set; and

determining, for each of the entities identified as being on the contact list but not having a set revocation flag, whether that entity is on a modified local revocation list, and if such an entity is determined to be on the modified local revocation list, setting its revocation flag in the contact list.

8.(Original) The method of claim 5 further including the step of updating the contact list if a new entity not already included in the contact list attempts to communicate with the given entity.

9.(Original) The method of claim 8 wherein the step of updating the contact list if a new entity not already included in the contact list attempts to communicate with the given entity further includes the steps of:

storing in the contact list an entity identifier for the new entity if there is sufficient space available in the contact list; and

determining if the new entity is on the revocation list, and

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if it is, setting the corresponding revocation flag for the new entity in the contact list.

10.(Original) The method of claim 9 further including the step of selecting a particular entry of the contact list for removal from the contact list if there is not sufficient space available in the contact list for the new entity.

11.(Original) The method of claim 10 wherein the selecting step is implemented using a random or pseudo-random selection process.

12.(Original) The method of claim 5 wherein the contact list is configured such that the revocation flag of a particular entry may not be cleared once that flag has been set as long as that entry remains in the contact list.

13.(Original) The method of claim 1 further including the step of periodically generating a digital signature for at least a

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portion of the contact list.

14.(Original) The method of claim 13 further including the step of updating the digital signature each time the contact list is updated.

15.(Original) The method of claim 1 wherein each of at least a subset of the other entities stores a contact list having entries corresponding to entities which have attempted to communicate with those other entities.

16.(Original) An apparatus for controlling access to information, the apparatus comprising:

a processor-based device for controlling access to the information, wherein the processor-based device is operative to maintain a contact list comprising information identifying one or more other entities which have attempted to communicate with the processor-based device, and to utilize the contact list in conjunction with a revocation list associated with the given entity

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to determine which of at least a subset of the one or more other entities are authorized to communicate with the processor-based device.

17.(Original) An article of manufacture comprising a machine-readable storage medium containing one or more software programs for use in controlling access to information, wherein the programs when executed implement the steps of:

maintaining, for a given entity controlling access to the information, a contact list comprising information identifying one or more other entities which have attempted to communicate with the given entity; and

utilizing the contact list in conjunction with a revocation list associated with the given entity to determine which of at least a subset of the one or more other entities are authorized to communicate with the given entity.

18. (Previously presented) The apparatus of Claim 16, wherein the contact list comprises a plurality of entries, each

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entry including at least an identifier of a particular one of the other entities and a corresponding revocation flag indicating whether authorization of the particular entity has been revoked.

19. (Previously presented) The article of manufacture of Claim 17, wherein the contact list comprises a plurality of entries, each entry including at least an identifier of a particular one of the other entities and a corresponding revocation flag indicating whether authorization of the particular entity has been revoked.

20. (Previously presented) The article of manufacture of Claim 19, wherein the programs when executed implement the further step of updating the contact list after a modification of the revocation list.

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EVIDENCE APPENDIX

None

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RELATED PROCEEDINGS APPENDIX

None